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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,362	03/04/2002	Naoto Yamada	Q67143	2731

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08/07/2003

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EXAMINER

TRAN, HUAN HUU

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

FILE COPY

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Office Action Summary

Application No.

10/086,362

Applicant(s)

YAMADA, NAOTO

Examiner

Huan H. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-20 is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10 are indefinite regarding the lack of positive recitation in the claim of sufficient structural limitations to support the functional language with respect to the functions of the conveyance rollers. In other words, the conveyance rollers themselves cannot perform the functions recited without the control of some controller. MPEP 2173.05(g).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the

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invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 2000-206638 cited in the IDS filed on 03/04/02.

JP 2000-206638 discloses an image recording apparatus for exposing a photosensitive material to record an image on the photosensitive material, comprising a nipping and conveyance arrangement for aiding in conveying the photosensitive material along a conveyance path in the image recording apparatus, the nipping and conveyance arrangement comprising:

two pairs of conveyance rollers mountable in the image recording apparatus, with one pair (36) disposed upstream from an exposure position relative to conveyance direction of the photosensitive material along the conveyance path during exposure, and one other pair (38) disposed downstream from the exposure position, in which the pairs of conveyance rollers nip and convey the photosensitive material during exposure, at least the upstream pair of conveyance rollers nipping at least a leading edge of the photosensitive material when the photosensitive material passes through the upstream pair of conveyance rollers and the pairs of conveyance rollers releasing the photosensitive material, at least momentarily, after the leading edge has passed through the downstream pair of conveyance rollers.

Regarding the manner in which the conveyance rollers are operated, it should be noted that apparatus claims must be structurally distinguishable from the prior art. Apparatus claims cover what device is, not what device does, and thus invention need not operate differently than prior art in order to be patentable, but need only be different. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). MPEP 2114.

6. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(a and e) as being clearly anticipated by Kato et al. (US Patent No. 6343787).

Kato et al. discloses an image recording apparatus for exposing a photosensitive material to record an image on the photosensitive material, comprising a nipping and conveyance arrangement for aiding in conveying the photosensitive material along a conveyance path in the image recording apparatus, the nipping and conveyance arrangement comprising:

two pairs of conveyance rollers mountable in the image recording apparatus, with one pair (36) disposed upstream from an exposure position relative to conveyance direction of the photosensitive material along the conveyance path during exposure, and one other pair (38) disposed downstream from the exposure position, in which the pairs of conveyance rollers nip and convey the photosensitive material during exposure, at least the upstream pair of conveyance rollers nipping at least a

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leading edge of the photosensitive material when the photosensitive material passes through the upstream pair of conveyance rollers and the pairs of conveyance rollers releasing the photosensitive material, at least momentarily, after the leading edge has passed through the downstream pair of conveyance rollers.

Regarding the manner in which the conveyance rollers are operated as recited in claims 1, 3 and 5, it should be noted that apparatus claims must be structurally distinguishable from the prior art. Apparatus claims cover what device is, not what device does, and thus invention need not operate differently than prior art in order to be patentable, but need only be different. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). MPEP 2114.

7. Claims 1, 2, 3, 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Arai et al (US Patent No. 5713504, which corresponds to JP 09-211914 cited in the IDS filed on 03/04/02).

With respect to claims 1, 3 and 5, Arai et al. discloses an image recording apparatus for exposing a photosensitive material to record an image on the photosensitive material, comprising a nipping and conveyance arrangement for aiding in conveying the photosensitive material along a conveyance path in the image recording apparatus, the nipping and conveyance arrangement comprising:

two pairs of conveyance rollers mountable in the image recording apparatus, with one pair (78) disposed upstream from an exposure position relative to conveyance direction of the photosensitive material along the conveyance path during exposure, and one other pair (80) disposed downstream from the exposure position, in which the pairs of conveyance rollers nip and convey the photosensitive material during exposure, at least the upstream pair of conveyance rollers nipping at least a leading edge of the photosensitive material when the photosensitive material passes through the upstream pair of conveyance rollers and the pairs of conveyance rollers releasing the photosensitive material, at least momentarily, after the leading edge has passed through the downstream pair of conveyance rollers.

Regarding the manner in which the conveyance rollers are operated as recited in claims 1, 3 and 5, it should be noted that apparatus claims must be structurally distinguishable from the prior art. Apparatus claims cover what device is, not what device does, and thus invention need not operate differently than prior art in order to be patentable, but need only be different. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). MPEP 2114.

With respect to claim 2, Arai et al. discloses an alignment section (104) for aligning edges substantially parallel to the conveyance path of the photosensitive material, in a direction substantially orthogonal to the conveyance path, mountable upstream from the two pairs of conveyance rollers.

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Allowable Subject Matter

8. Claims 11-20 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter: Prior art of record do not teach or suggest the combinations as claimed for reducing paper jam.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huan H. Tran whose telephone number is (703) 308-0749. The examiner can normally be reached on M-F with Monday off, from 7:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703)872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1749.



Huan H. Tran
Primary Examiner
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hht
July 31, 2003